**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

| | | |
|---|---|---|
| In re application of: | ) | Confirmation No.: 5968 |
| | ) | |
| Jay Rossiter et al. | ) | Examiner: Shahid Al Alam |
| | ) | |
| Serial No.: 10/762,949 | ) | Group Art Unit No.: 2162 |
| | ) | |
| Filed on: January 21, 2004 | ) | |
| | ) | |

For: PRE-DEFINED HARDWARE AND SOFTWARE BUNDLE READY FOR DATABASE APPLICATIONS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

**REPLY BRIEF**

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on November 28, 2007.

## I. STATUS OF CLAIMS

Claims 1-6, 8-11, 16-26, 31, and 33 are pending in this application. Claims 1-6, 8, 9, 11, 16-24, 26, 31, and 33 were finally rejected in the Final Office Action mailed on November 3, 2006. Claims 10 and 25 were objected to for being dependent upon a rejected base claim. Claims 7, 12-15, 27-30, 32, and 34 were canceled during prosecution.

Claims 1-6, 8, 9, 11, 16-24, 26, 31, and 33 are the subject of this appeal.

## II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3, 5, 6, 8, 9, 11, 16-18, 20-24, 26, 31, and 33 stand rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over U.S. Patent No. 5,606,693 issued to Nilsen et al. ("*Nilsen*") in view of "The ServOS Kernal" written by Stefan Schleipfer ("*Schleipfer*").

Claims 4 and 19 stand rejected under 35 U.S.C. 35 U.S.C. § 103(a) for allegedly being unpatentable over *Nilsen* and *Schleipfer* and further in view of U.S. Patent No. 5,627,994 issued to Levy et al. ("*Levy*").

## III. ARGUMENTS

In the Examiner's Answer, the Examiner responds to various arguments in the Appeal Brief filed on August 31, 2007, which arguments the Examiner labeled as Argument No. 1-5.

### A. ARGUMENT NO. 1

The Examiner's Answer asserts that Argument No. 1 is that the "combination of Nilsen and Schliepfer fails to teach or suggest the database appliance of claim1" (page 10). In response to this argument, the Examiner's Answer merely provides a few statements that include some terms in common with Claim 1, such as databases, general purpose operating systems, special purpose operating systems, configuration, and database server. Merely referring to portions of cited art that include terms that are in common with terms in a rejected claim does not render that claim anticipated or obvious. MPEP § 2106(II)(C) warns that "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, **the claim as a whole must be considered**" (emphasis added). It is respectfully submitted that the Examiner has participated in illicit dissection in rejecting Claim 1.

The Examiner's response to Argument No. 1 fails to address the argument that *Nilsen* and *Schliepfer* fail to teach or suggest, both individually and in combination, a single database appliance that comprises **three** elements: a database server, a special purpose operating system, and a self-configuration module.

The Examiner's response also fails to address the argument that *Nilsen* **teaches away** from the recited database appliance of Claim 1. For example, the database servers 120-124 of *Nilsen* (i.e., the alleged database server of Claim 1) and the configuration controllers 132 and

134 of *Nilsen* (i.e., the alleged self-configuration module of Claim 1) each reside on separate computing machines (see col. 3, lines 24-28 of *Nilsen*).

### B. ARGUMENT NO. 2

The Examiner's Answer asserts that Argument No. 2 is that "Nilsen fails to disclose the self-configuration module of claim 1" (page 10). In response to this argument, page 12 of the Examiner's Answer merely states that "Nilsen teaches a system that has database server and configuration controller, the configuration controller contains configuration data." This response does not address the argument (on page 7 of the Appeal Brief) that indicates that *Nilsen* fails to mention anything related to detecting an environment in which a database appliance is being used, much less that the configuration controllers 132 and 134 of *Nilsen* detect such an environment.

### C. ARGUMENT NO. 3

The Examiner's Answer asserts that Argument No. 3 is: "No portion of Nilsen discusses configuring a database appliance as claimed" (page 10). In response to this argument, page 12 of the Examiner's Answer merely states:

> Nilsen teaches a system that has database server and configuration controller, the configuration controller contains configuration data (see column 3, lines 21- 65 and Figure 1). The configuration data showing how many database servers are available and how they are to be accessed. The database server also maintains configuration information.

This response fails to address appellants' argument that the configuration controllers 132 and 134 of *Nilsen* do not configure a database appliance, i.e., an appliance that includes a database server, a special purpose operation system and a self-configuration module. Even if the configuration controller 132 could be characterized as able to "configure" a database server of *Nilsen*, the configuration controller 132 does not configure such database servers based upon a

detected environment. Rather, the configuration controller 132 merely (1) evaluates a request from a requestor workstation 104 and (2) "assigns [the request to] database servers based on the type of request, the load on each of the servers, and priority information" (col. 3, lines 61-63). The configuration controller 132 also "maintains a record of information about the type of request, and the start and end times for that logging request" (col. 3, lines 63-65). None of these functions of the configuration controller 132 configures a database server, much less a database appliance as claimed.

### D. ARGUMENT NO. 4

The Examiner's Answer asserts that Argument No. 4 is: "Since Schleipfer and Nilsen individually do not show multiple features of claim 1, it follows that the combination of Schleipfer and Nilsen also fails to disclose, teach or suggest the multiple features of claim 1" (page 10). In response to this argument, page 12 of the Examiner's Answer merely states:

> the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

It is respectfully noted that the Examiner is attempting to show obviousness by *combining* prior art references and **not** *modifying* the teachings of the prior art. The Examiner alleges that "Nilsen teaches configuration controller that manages the process through which data is logged from a workstation to database server (column 3[, lines 44-46]) and Schleipfer teaches to configure a server machine and to change a configuration dynamically (page 121)."

Specifically, *Schleipfer* states: "It should be possible to configure a server machine with an [in principle] arbitrary number of server modules of arbitrary types (file, mail, etc.) and to change a configuration dynamically." Even if Schleipfer and Nilsen could be combined, neither

this statement by *Schleipfer* nor the configuration controller 132 of *Nilsen* teaches or suggest the recited self-configuration module of Claim 1, i.e. a module, of a database appliance, that is capable of "detecting an environment in which the database appliance is being used; and configuring the database appliance based upon the detected environment" (emphasis added).

### E. ARGUMENT NO. 5

The Examiner's Answer asserts that Argument No. 5 is: "Nilsen lacks any teaching or suggestion of 'removing one or more features of a general purpose operating system that are not required to provide a set of services to the database server' as Claim 16 requires" (page 10). In response to this argument, pages 13-14 of the Examiner's Answer states:

> This rejection is in combination of Schleipfer and Nilsen. Schleipfer teaches distributed computer systems consisting of dedicated user and server machines and operating system (OS) that support to server modules loaded on server machines. A special purpose OS and a general purpose operating system are discussed.
>
> In servOS, the kernels and the base system use a state model for server module that differs from the state model for normal program executions supported by general-purpose OSs. Server modules are long-term existing objects managed by the base system and the kernels. The base system provides operations for creating and deleting them (page 122 – 123).

It appears that the Examiner equates the "general-purpose kernel" of *Schleipfer* (see col. 2, section 2 of page 121) with the general purpose operating system of Claim 16 and the "special-purpose kernel" of *Schleipfer* with the special purpose operating system of Claim 16. Even if these correlations were true, *Nilsen* and *Schleipfer* still fail to teach or suggest, individually and in combination, "removing one or more features of a general purpose operating system that are not required to provide a set of services to the database server."

The difference between the general-purpose and special-purpose kernels of *Schleipfer* is that a general-purpose kernel supports user programs and server modules while a special-

purpose kernel supports only server modules. In order to read on Claim 16, *Schleipfer* would have to at least disclose that the components of a special-purpose kernel are generated by removing user programs (from a general-purpose kernel) that are not required to provide a set of services required by a database server. However, *Schleipfer* fails to teach or suggest that a set of components of a special-purpose kernel is generated by removing one or more user programs of a general-purpose kernel.

Fundamentally, in contrast to the Examiner's assertion on page 5, the cited art fails to teach a method for **constructing** a **database appliance**, much less by the method recited in Claim 16. Instead, *Nilsen* "is directed to providing a fully redundant distributed database management application" (col. 2, lines 15-16; emphasis added), and *Schleipfer* is directed to investigating an operating system to support server modules loaded on server machines (abstract). The prior art references individually and in combination are completely unrelated to constructing a database appliance, i.e., by installing a database server and a special purpose operating system on the same computer readable medium.

## F. EXAMINER FAILS TO ADDRESS ADDITIONAL ARGUMENTS FROM THE APPELLANTS

The section of the Appeal Brief beginning on page 8 and ending on page 9 was not addressed in the Examiner's Answer. The Examiner's Answer also failed to address appellants' argument regarding dependent Claims 3, 17, and 18.

## G. EXAMINER FAILS TO PROVIDE A REASON FOR COMBINING THE PRIOR ART REFERENCES

MPEP § 2143 provides multiple examples rationales that an Examiner may rely on to support a conclusion of obviousness. From the Office actions and the Examiner's Answer, the rejections appear to be based on rationale G of MPEP § 2143, which states: "Some teaching,

suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." In rejecting each of the claims, the Examiner alleged that one prior art reference (e.g., *Nilsen*) teaches one or more features of a particular claim and then alleged that another prior art reference (e.g., *Schleipfer*) teaches the remaining features of the particular claim. Therefore, the Examiner is relying on a simple combination of the prior art references to teach or suggest all the features of each claim. However, not only is there no reason to combine the cited art references, even the combination thereof would fail to teach or suggest Claims 1 and 16 (which is outlined on page 9 of the Appeal Brief).

For example, the Examiner contends that:

> [i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Schleipfer with Nilsen to increase the ease and efficiency of the configuration management task in a distributed computer systems. The ServOS kernel of Schleipfer takes simpler solutions where problems are easier to solve on server machines and it further gives the server modules a higher-level OS support (see page 121; Schleipfer).

The first underlined feature merely describes the benefits of *Nilsen*'s approach, whereas the second underlined feature is from *Schleipfer*'s abstract and merely describes the benefits of *Schleipfer*'s approach. Merely describing the benefits of two prior art references is not enough to show obviousness without showing why one of ordinary skill in the art at the time of the invention would want to combine the respective teachings.

## H. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is respectfully submitted that the rejection of Claims 1-6, 8, 9, 11, 16-24, 26, 31, and 33 under 35 U.S.C. § 103(a) being unpatentable over the cited art lacks the requisite factual and legal bases. Appellants therefore respectfully request that the

Honorable Board reverse the rejection of Claims 1-6, 8, 9, 11, 16-24, 26, 31, and 33 under 35 U.S.C. § 103(a).

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

/DanielDLedesma#57181/
Daniel D. Ledesma
Reg. No. 57,181

**Date: January 28, 2008**
2055 Gateway Place, Suite 550
San Jose, CA 95110-1089
Telephone: (408) 414-1229
Facsimile: (408) 414-1076